

Remarks/Arguments

Claims 1-8 and 10-11 are pending in the application.

Rejection Under 35 U.S.C. § 103 Should Be Withdrawn

Claims 1-8 and 10-11 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Albert et al., WO 02/38561 A1 (hereinafter referred as "the '561 application"). Specifically, the Examiner states that the '561 application teaches the R position to be phenyl or naphthelene, and pyrimidine or quinazoline, and therefore it would have been obvious for one skilled in the art to follow the synthetic scheme of '561 application and substitute pyridine for quinoline to make the claimed invention with a reasonable expectation of success.

Applicants respectfully disagree. To properly determine a *prima facie* case of obviousness, the Examiner "must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." M.P.E.P. § 2142. This is important as "impermissible hindsight must be avoided and the legal conclusion must be gleaned from the prior art" *Id.* Four factual inquiries must be made: first, a determination of the scope and contents of the prior art; second, a determination of the differences between the prior art and the claims in issue; third, a determination of level of ordinary skill in the pertinent art; and fourth, an evaluation of evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Three criteria may be helpful in determining whether claimed subject matter is obvious under 103 (a): first, if there is some suggestion or motivation to modify or combine the cited references; second, if there is a reasonable expectation of success; and third, if the prior art references teach or suggest all the claim limitations. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). "Knowledge in the prior art of every element of a patent claim ... is not of itself sufficient to render claim obvious." *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Teleflex Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1333-1334 (Fed. Cir. 2002). The issue is whether there is apparent reason to combine (or to modify, in this case) the known elements in the fashion claimed by the patent at issue. *KSR Int'l Co. v. Teleflex, Inc.*

As the Examiner correctly pointed out, the '561 application teaches that R position can be phenyl, naphthelene, pyrimidine, or quinazoline, but does not teach that R position can be a pyridyl group. Nowhere in the '561 application provides any suggestion to a person of ordinary skill in the art not to use various chemical groups described, and instead, substitute such a chemical group with a pyridyl group. A person of ordinary skill in the art would not consider a pyridyl group to be equivalent to a quinoline or isoquinoline group, since these groups deviate from each other significantly, unless there is a clear teaching or suggestion to their equivalent effect. The Examiner had not pointed out any document that provides such teaching or

suggestion, based on which said correlation could have been made plausible or credible. Thus, it would not have been obvious for a person of ordinary skill in the art to substitute pyridyl group at the R position to achieve the same therapeutic effect.

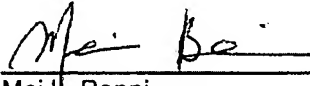
Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 (a) are respectfully requested.

CONCLUSION

Applicants respectfully request that the remarks made herein be entered and made of record in the file history of the present application. Withdrawal of the Examiner's rejection and a notice of allowance are requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Respectfully submitted,

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